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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,014	02/08/2005	Aurelio Romeo	5059-0102PUS1	7574

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EXAMINER	
BEKKER, KELLY JO	

ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
10/27/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/524,014	ROMEO, AURELIO	
	Examiner	Art Unit	
	Kelly Bekker	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 July 2008 and 03 September 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24,25,27-32,35,37-54 and 56-74* is/are pending in the application.

4a) Of the above claim(s) *57-68* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24,25,27-32,35,37-54,56 and 69-74* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Amendments made 7/11/08 have been entered.
Claims 24, 25, 27-32, 35, 37-54, 56-74 remain pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/3/08 has been entered.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The 103(a) rejection of claims 24, 25, 27-30, 35, 37-44, 69, and 70 over Glasser (US 4140809) in view of Tanglertpaibul (XP 002043494 has been withdrawn based on applicant's amendments and arguments filed 9/3/08. Specifically, Glasser teaches of a soup composition with a particular soluble solids to insoluble solids ratio; Glasser does not teach or provide motivation for a tomato composition with a specific ratio of tomato insoluble solids to tomato soluble solids.

The 103(a) rejection of claim 31 as being unpatentable over Glasser (US 4140809) in view of the Benefits ("The Benefits of Olive Oil") has been withdrawn based on applicant's amendments and arguments filed 9/3/08. Specifically, Glasser teaches of a soup composition with a particular soluble solids to insoluble solids ratio; Glasser does not teach or provide motivation for a tomato composition with a specific ratio of tomato insoluble solids to tomato soluble solids.

The 103(a) rejection of claims 32, 73, and 74 over Glasser (US 4140809), in view of Terrytx (Creamy Tomato Cheese Soup, 1999 Recipelink.com) has been withdrawn based on applicant's amendments and arguments filed 9/3/08. Specifically, Glasser teaches of a soup composition with a particular soluble solids to insoluble solids ratio;

Glasser does not teach or provide motivation for a tomato composition with a specific ratio of tomato insoluble solids to tomato soluble solids.

The 103(a) rejection of claims 24, 25, and 45-56 over Bueno (EP 0888718 A1) has been withdrawn based on applicant's amendments and arguments filed 9/3/08.

Claims 24, 25, 27-32, 35, 37-54, 56, and 69-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bueno (EP 0888718 A1) in view of de la Cuadra et al (US 2003/0224100 A1).

Bueno teaches of a tomato composition prepared from tomatoes containing tomato juice, by a process comprising heating the tomatoes to inactivate enzymes and separation of tomato serum from water insoluble solids using a separation solid-liquid apparatus wherein the tomato juice is maintained under stirring (Abstract). Bueno teaches that the separation can be achieved with a sieve with a paddle type extractor (i.e. a vessel having walls with slots or holes). Bueno teaches that the sieve holes are 0.6-2.2mm and that the sieve operates at different speeds depending on the apparatus utilized. Bueno teaches that a paddle type extractor operates at 100-500rpm. Bueno teaches that the insoluble material separated is macerated to particles with a diameter of less than 0.15mm and then recombined with the tomato serum. Bueno teaches that the stirrer in the separation apparatus can be near the wall to force the tomato against the screen or can allow the tomato to naturally press against the screen. Refer specifically to Page 4 line 1 through Page 5 line 19. Bueno teaches that the separation is performed at room temperature and atmospheric pressure (Example 1). Bueno teaches that the tomato juice derived product can be mixed with foods (Claim 11). Bueno teaches that the tomato composition includes salt, i.e. a preservative (page 5, lines 25-26). Bueno teaches that the composition consists essentially of tomatoes and includes about 29% solids, i.e. 29% tomato solids (Table 3). Bueno teaches that the Brix of the tomato composition is 28% (Table 3), thus Bueno teaches that the composition contains about 28% soluble tomato solids out of the 29% dry tomato matter, or about 96% of the dry mater is tomato soluble solids and about 4% of the dry mater is tomato insoluble solids. Note: The calculations are based on the reference

submitted by applicant (October 17, 2007), "Tomato Production, Processing and Technology Third Edition" by Gould et al., page 317, which states "Another portion of the total solids content of the tomato that is as important as the Brix value, is the water insoluble solids content. This measurement is the difference between the Total Solids content and the Brix value."

Bueno does not specifically teach the tomato composition as including 5.5-20% dry matter as recited in claims 24, 27, 37, 39, and 45, to the water insoluble tomato solids as about 18-30%, preferably 20-30%, of the dry residue and to the water soluble tomato solids as 70-82%, preferably 70-80% of the dry residue as recited in claims 24, 25, 27, 37, 39, and 45, to the composition as admixed with 10-25% fats or oils, preferably butter, margarine, or olive oil as recited in claims 27-31, 35, and 40, to the tomato composition as admixed with 10-25% or 50-300% cheese as recited in claims 32, 73, and 74, to the composition as combined with food that is pasta, meat, fish, or vegetables as recited in claim 38, to the separation stirrer under an angular speed of 1-20rpm, preferably 2-10rpm, as recited in claims 45 and 52, to the separation sieve as under oscillating motion at 1-20 oscillations per minute as recited in claim 46, to the tomato composition as sterilized or processed under sterile conditions as recited in claim 47, to separation at a temperature of 10-15C as recited in claim 48, and the characteristics of the holes in the separation apparatus as recited in claims 49, 50, 51, 53, and 54, to the tomato product as added to a serum concentrated by osmosis or evaporation as recited in claim 56, and to the tomato composition as obtained from tomato passatas as recited in claims 70 and 72.

De la Cuadra et al (Cuadra) teaches of tomato based products which are formed by separating a tomato juice into a first stream heavy with tomato insoluble solids and a second stream with tomato soluble solids and recombining the streams into particular tomato soluble: insoluble solids ratios (Abstract). Cuadra teaches that the amount of tomato solids effects the flavor and consistency of the tomato product (paragraph 0009). Cuadra teaches that the tomato composition may contain more or less water depending on the desired end product (paragraphs 0016 and 0017). Cuadra teaches that the tomato composition contains at least about 0.5%, preferably 2-50% of olive oil, cheeses,

butter, spices, and combinations thereof (paragraph 0029). Cuadra teaches that the product of the invention may be in the form of ketchup, pasta sauce, or vegetable spreads (paragraph 0030). Cuadra teaches of adding the tomato composition to a serum concentrated by evaporation, i.e. treated by boiling, in order to form a tomato mousse product (Example 5).

Regarding the tomato composition as including 5.5-20% dry matter, it would have been obvious to one of ordinary skill in the art at the time the invention was made to increase the amount of water in the tomato composition if the final product to be produced was a soup, so that the soup was in a pre-made form and the tomato composition did not need to be diluted upon consumption. To adjust the water content of the tomato composition based upon the desired final product would have been obvious and within the routine determination of one of ordinary skill in the art at the time the invention was made as taught by Cuadra.

Regarding the water insoluble tomato solids as about 18-30%, preferably 20-30%, of the dry residue and to the water soluble tomato solids as 70-82%, preferably 70-80% of the dry residue, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the tomato soluble solids and insoluble solids depending on the desired viscosity, texture, and flavor of the final tomato composition. To adjust the tomato soluble solid levels and tomato insoluble solid levels in a tomato composition depending on the desired properties of the final product was known as taught by Bueno and Cuadra and would be routine determination and would not impart a patentable distinction to the claims absent criticality or unexpected results.

Regarding the composition as admixed with 10-25% fats or oils, preferably butter, margarine, or olive oil and the tomato composition as admixed with 10-25% or 50-300% cheese, it would have been obvious to one of ordinary skill in the art at the time the invention was made to admix 2-50% additional materials, including cheese, butter, or olive oil depending on the final product being produced and the flavor and fat content desired in the final product as taught by Cuadra.

Regarding the composition as combined with food that is pasta, meat, fish, or vegetables, as taught by Cuadra, it was known to combine tomato compositions with

pastas, to do so would have been obvious to one of ordinary skill in the art at the time the invention was made in order to form a final product that contained pasta.

Regarding the separation stirrer under an angular speed of 1-20rpm, preferably 2-10rpm, and the separation sieve as under oscillating motion at 1-20 oscillations per minute, Bueno teaches that the process includes separation with a solid-liquid apparatus at a rotational speed of 100rpm. One of ordinary skill in the art at the time the invention was made would expect the product separated by an apparatus at 1-20rpm, including 2-10rpm, or at 1-20 oscillations per minute to be similar to the product separated by an apparatus at 100rpm, as one of ordinary skill would expect the revolutions per minute or oscillations per minute of the sieve separation apparatus to affect the processing parameters (i.e. such as processing time, the speed at which the composition was separated, the amount of cleaning of the sieve holes required during processing, ect) and not materially affect the product produced, absent any clear and/or convincing arguments and/or evidence to the contrary. Applicant is reminded that "Patentability shall not be negatived by the manner in which the invention was made" and that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Regarding the tomato composition as sterilized or processed under sterile conditions, it was known in the art at the time the invention was made to sterilize food made for human consumption. Since the product produced by Bueno is intended for human consumption (Page 2- State of the Art), one of ordinary skill in the art at the time the invention was made would have been motivated to sterilize it in order to prevent the consumption of non-sterile material which could cause sickness to the consumer.

Regarding separation at a temperature of 10-15C, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the separation temperature of the tomato composition to be lower than room temperature, such as 10-

15C, in order to help preserve the food product until preservatives could be added; lower temperatures were known to preserve food products at the time the invention was made and to treat a product at lower temperatures for the purpose of preservation would be within the ordinary ingenuity of one of ordinary skill in the art at the time the invention was made and would not impart a patentable distinction to the claims.

Regarding the characteristics of the holes in the separation apparatus, specifically regarding the separation apparatus with holes diameters not greater than 0.1mm, Bueno teaches that the separation holes are from 0.6-2.2mm in diameter. Bueno teaches that the insoluble material separated is macerated to particles with a diameter of less than 0.15mm and then recombined with the tomato serum. Since Bueno teaches that the insoluble materials reintroduced into the tomato serum are of a diameter less than 0.15mm, it would have been obvious to one of ordinary skill it the art at the time the invention was made for the separation hole diameters to also be less than 0.15mm, including less than 0.1mm, in order to form a smooth consistent product. Specifically regarding the process as including a concave or flat shaped sieve made out of a specific material, with a specific diameter, and with specific slot lengths, one of ordinary skill it the art would not expect the size or shape or material of the sieve to materially affect the product produced, absent any clear and/or convincing arguments and/or evidence to the contrary. Similarly, one of ordinary skill it the art would not expect the slot lengths of the sieve to materially affect the product produced, absent any clear and/or convincing arguments and/or evidence to the contrary.

Regarding the tomato product as added to a serum concentrated by osmosis or evaporation, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the tomato product with another food product, such as a serum concentrated by evaporation depending on the final product desired. One would have been motivated to combine the tomato product with a serum concentrated by evaporation in order to form a tomato mouse product as taught by Cuadra.

Regarding the tomato composition as obtained from tomato passatas, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the tomato composition to be derived from the most readily available tomato product,

such as tomato juice or tomato passatas; to use tomato juice or tomato passatas as a starting source would not impart a patentable distinction to the claims absent any clear and convincing arguments and/or evidence to the contrary.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection as stated above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Bekker whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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